

REMARKS

Amendments to the Claims

Claim 1 has been amended and claims 51-53 have been added to point out more particularly and claim more distinctly the subject matter of the present invention. Support for the addition of claims 51-54 can be found in the specification at, for example, page 12, lines 29-34, page 13, lines 10-14, page 19, lines 16-17, and page 20, lines 25-28. Claim 23 has been converted to an independent claim. Claims 16, 20, 37, 47 and 50 have been canceled without prejudice to reinstate. Claim 20 has been represented as claim 55 in view of the addition of claim 54. No new matter has been added by way of these amendments. Thus, claims 1-15, 17-19, 21-36, 38-46, 48, 49, and 51-54 are now pending, claims 45, 46, 48, and 49 having been added by preliminary amendment.

The Office Action

The Office has rejected claims 1-44 (claims 16, 20 and 37 having been canceled) under 35 U.S.C. § 103(a) as obvious in view of and, therefore, unpatentable over Yeung et al. (U.S. Pat. No. 5,324,401) in view of Gilby et al. (U.S. Pat. No. 5,900,934). Reconsideration of this rejection is hereby requested.

Discussion of Rejection under 35 U.S.C. § 103

The Office has rejected claims 1-44 (claims 16, 20 and 37 having been canceled) under Section 103(a) as obvious in view of and, therefore, unpatentable over Yeung et al. in view of Gilby et al. This rejection is traversed for the reasons set forth below.

While Yeung et al. may show a method and apparatus for optically analyzing an array of multiple samples simultaneously by irradiating the array with light and detecting light from the samples with a detection means positioned apart from the array of multiple containers, Yeung et al. uses the system to measure fluorescence of the sample -- not absorption, which is measured using the system and method of the present invention. The Office admits as much in the Office Action at page 2, section 2, third full paragraph.

In spite of this, the Office contends that it was known in the art that samples in capillary tubes could be tested by measuring absorption, citing Gilby et al. The Office concludes that it would have been obvious to adapt the system of Yeung et al. to measure absorption as allegedly taught by Gilby et al. Yet, nowhere has the Office pointed to a teaching or suggestion to modify the system of Yeung et al. as proposed by the Office. Furthermore, adapting the system of Yeung et al. to measure absorption would render the system of Yeung et al. unsuitable for its intended purpose, i.e., to measure fluorescence. See, e.g., *In re Gordon et al.*, 733 F.2d 900, 221 U.S.P.Q. 1125 (C.A.F.C. 1984); *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992); and M.P.E.P. § 2143.01. A system that

measures fluorescence requires a different optical geometry from that of a system that measures absorption.

Even if, for the sake of argument, the system of Yeung et al. were modified in view of Gilby et al., Gilby et al. requires the use of a mask. See, for example, column 5, lines 4-9, of the '934 patent. The present invention obviates the need for a mask by positioning the detection means in line with the light source and in line with and parallel to the planar array at a distance of at least about 10 times a cross-sectional distance of a container in the planar array as measured orthogonally to the plane of the planar array. While the Office contends that one of ordinary skill in the art would have been motivated to position the detection means accordingly as a way of avoiding an expensive extremely wide-angle lens, Applicants point out that there must be some teaching or suggestion in the art NOT to use a mask and, as pointed out, modification of the system of Yeung et al. in view of Gilby et al. would already render the system of Yeung et al. unsuitable for its intended purposes. Therefore, the Office's further contention regarding obviating the need for a wide-angle lens can only be characterized as an attempt at impermissible hindsight reconstruction. The same can be said for the Office's characterization of Yeung et al.'s disclosure of a "standard distortion free camera lens" as suggesting a lens that would not place the detector extremely close to the capillaries. Placement of a wide angle lens or any other lens between the array and the detector would only serve to match the size of a container, e.g., a capillary tube, in the array to the detector element. It would not serve to reduce interference between containers in the array.

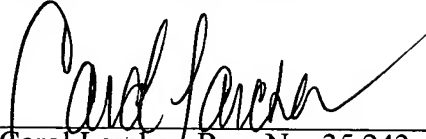
In view of the foregoing, the present invention cannot be said to be obvious in view of Yeung et al. in view of Gilby et al. Accordingly, Applicants request the withdrawal of this rejection.

Conclusion

In view of the above remarks, the application is considered to be in good and proper form for allowance. If, in the opinion of the Office, a telephone conference would help to expedite prosecution of the instant application, the Office is invited to contact the undersigned attorney.

In re Appln. of Yeung et al.
Application No. 10/070,531

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